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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/366,081 08/02/99 BRENNER

S 802-04RE

EXAMINER

HM22/0816

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SHIBUYA, M

ART UNIT

PAPER NUMBER

1635

DATE MAILED:

08/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/366,081

Applicant(s)
BRENNER

Examiner
Mark L. Shibuya

Group Art Unit
1635



☒ Responsive to communication(s) filed on May 17, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-6 and 8-13 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-4 and 10-13 is/are allowed.

☒ Claim(s) 5, 6, 8, and 9 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Response to Arguments

1. The applicants' response filed 5/17/200, has been considered. Rejections and/or objections not reiterated from the previous office action mailed 4/25/00, are hereby withdrawn. The following rejections and/or objections are either newly applied or are reiterated and are the only rejections and/or objections presently applied to the instant application.
2. All rejections have been withdrawn in view of applicant's fully executed Reissue Declaration, terminal disclaimers, amendments, and remarks, filed 5/17/00.

Nucleotide and/or Amino Acid Sequence Disclosure

3. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the following reason(s): The text of the specification discloses nucleotide or amino acid sequences but the this application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c) that complies with the **new sequence rules**. Also, a copy of the "Sequence Listing" in computer readable form that complies with the **new sequence rules** has not been submitted as required by 37 C.F.R. 1.821(e).

Applicant must provide:

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a. An initial computer readable form (CRF) copy of the "Sequence Listing" that complies with the new sequence rules.

b. An initial paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification that complies with the new sequence rules.

c. A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

Applicant is required to comply with the corrections for the sequence listing as per above as part of a complete response to this official action. The examiner regrets any inconvenience resulting from the suggestion in the previous Office action to use the sequence listing for that of 08/484,712, filed 6/5/95, now U.S. Patent No. 5,654,413.

Claim Rejections - 35 U.S.C. § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 5, 6, 8, and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a New Matter rejection.

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a. Newly amended claims 5, 6, 8, and 9 now recite the limitation “genomic DNA fragments”. Applicant has not pointed with particularity where support for this new limitation may be found in the application as filed. Absent evidence to the contrary, no support is found for this limitation in the specification as filed.

Conclusion

6. Claims 5, 6, 8 and 9 are rejected. Claims 1-4 and 10-13 are allowed.
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
8. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Mark L. Shibuya (SRC)*, *Ph.D.*, whose telephone number is (703) 308-9355.

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10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *George Elliott, Ph.D.* may be reached at (703) 308-4003.
11. Any inquiry of a general nature or relating to the status of this application should be directed to the *Group receptionist* whose telephone number is (703) 308-0196.

ms
Mark L. Shibuya
Patent Examiner
Technical Center 1600
August 14, 2000

George C. Elliott

George C. Elliott, Ph.D.
Supervisory Patent Examiner
Technology Center 1600